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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Benjamin E. Morris

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EXAMINER

SONNETT, KATHLEEN C

ART UNIT

PAPER NUMBER

3731

MAIL DATE

DELIVERY MODE

07/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/757,680

Applicant(s)

MORRIS ET AL.

Examiner

Kathleen Sonnett

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 32-38 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 7-19, 24-31, 39, 40 and 45-52 is/are rejected.
- 7) ☒ Claim(s) 1-52 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-52 have been considered but are moot in view of the new ground(s) of rejection. It is noted that claim 17 was not rejected with art but was rejected under 35 U.S.C. 112 1st paragraph because the actuator of the instant application contains no structure that prohibits longitudinal attachment of a medical device to the actuator. The language of the claim has been changed and such structure is no longer required for prior art to read on the claim.

Claim Objections

2. Claims 1-52 are objected to because of the following informalities: the proximal actuator, actuation sleeve, and the medical device are all positively recited and the preamble should be drawn to the combination of these elements. The preamble of claim 1 should be changed to "a proximal actuator in combination with an actuation sleeve and a medical device". The remaining claims should also include the combination of these elements in their preambles. Appropriate correction is required.

3. Additionally, it is suggested that "actuator sleeve" in lines 3 and 4 of claim 15 be changed to "actuation sleeve" for consistency (see claim 1 from which 15 depends).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claim 10** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described

in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Although the instant specification includes that the actuator is laterally and not longitudinally attached (mounted) to the actuation sleeve/medical device, the limitation "not longitudinally *attachable*" is different than "not longitudinally *attached*". "Not longitudinally attachable" covers the fact that the actuator cannot be longitudinally attached to a medical device. No embodiment is presented with structure that would prohibit an actuation sleeve from being longitudinally attached to the retaining devices.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1, 2, 7-9, and 11-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mosior (U.S. 4,084,594) in view of Darrey (U.S. 3,609,638). Mosior discloses a proximal actuator in combination with a medical device and an actuation sleeve. The proximal end of the actuation sleeve is divided into a first section (17) and a second section (16a) and a wire or tube member (15) is movably retained in the sleeve but fixed to the second section of the sleeve, wherein longitudinal movement of the sleeve relative to the wire or tube member operates the medical device at the distal end of the sleeve. The actuator comprises an actuator body operatively mounted to the proximal end of the sleeve and a medical device is operatively mounted to the distal end of the sleeve. The actuator body has two retaining devices (27, 24), one being movably mounted (24). The first retaining device is laterally removably attached and

Art Unit: 3731

not longitudinally attached to the first section of the actuation sleeve and the second retaining device is laterally removably attached to the second section of the actuation sleeve. The second retaining device is movable relative to the first retaining device such that the medical device is activated (col. 6 ll. 14-45). Mosior discloses that the first retaining device (27) is a laterally openable clip but fails to disclose that the second retaining device is also a laterally openable clip.

8. However, Darrey discloses that using two laterally openable clips are well known for use in clamping assemblies. These laterally openable clips are spring clips. Such clips are advantageous because they can be quickly adjusted without the use of special tools and at the same time have a tight hold on the object that is being clamped (col. 3 ll. 1-3). Making the second retaining device of Mosior a spring clip would improve the connection between the actuator and the medical device. Therefore, it would have been obvious to one of ordinary skill in the art to modify the device of Mosior to construct both of the retaining devices as laterally openable spring clips as made obvious by Darrey to strengthen the connection between the actuator and the actuation sleeve.

9. Regarding claim 2, Mosior discloses a grip portion (21c) having a sleeve defining an aperture, wherein the first retaining device is affixed to the sleeve (see fig. 1).

10. Regarding claim 7, the first retaining device is in a fixed position.

11. Regarding claims 8 and 9, the second retaining device is longitudinally movable from a first position to a second position relative to the first retaining member. The medical device has two positional states and movement between the first and second retaining devices affects this position (col. 3, ll. 41-58).

12. Regarding claim 15, wire (15) extends through the actuation sleeve and has a proximal end attached to the second section (16a) of the actuation sleeve.

13. Regarding claims 11-14, the clips as modified by Darrey are spring clips. Without further structure, any point of reference or any structure that aids in alignment on the spring clips can be considered an alignment indicator including the curved channel defined by the clamping ends 10b.

14. **Claims 18, 19, 24-31, 39, 40, and 45-52** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mosior in view of Darrey and Dormia (U.S. 4,347,846). Mosior discloses a proximal actuator in combination with a medical device and an actuation sleeve. The proximal end of the actuation sleeve is divided into a first section (17) and a second section (16a) and a wire or tube member (15) is movably retained in the sleeve but fixed to the second section of the sleeve, wherein longitudinal movement of the sleeve relative to the wire or tube member operates the medical device at the distal end of the sleeve. The actuator comprises an actuator body operatively mounted to the proximal end of the sleeve and a medical device is operatively mounted to the distal end of the sleeve. The actuator body has two retaining devices (27, 24), one being movably mounted (24). The first retaining device is laterally removably attached and not longitudinally attached to the first section of the actuation sleeve and the second retaining device is laterally removably attached to the second section of the actuation sleeve. The second retaining device is movable relative to the first retaining device such that the medical device is activated (col. 6 ll. 14-45). Mosior discloses that the first retaining device (27) is a laterally openable clip but fails to disclose that the second retaining device is also a laterally openable clip.

15. However, as disclosed in more detail above, Darrey teaches that using two laterally openable clips are well known for use in clamping assemblies. These laterally openable clips are spring clips. Such clips are advantageous because they can be quickly adjusted without the use of special tools and at the same time have a tight hold on the object that is being clamped

Art Unit: 3731

(col. 3 ll. 1-3). It would have been obvious to one of ordinary skill in the art to modify the device of Mosior to construct both of the retaining devices as laterally openable spring clips as made obvious by Darrey to strengthen the connection between the actuator and the actuation sleeve.

16. Mosior also fails to disclose that the medical device is an expandable frame for capturing embolic material. However, Mosior discloses that one of the main advantages of his handle assembly is that it allows a urologist to select any of a variety of different instruments for coupling to the universal handle unit in a quick manner so that surgery time is not prolonged (col. 1 ll. 31-49). Dormia discloses that expandable frame medical devices are employed by urologists to remove calculus from the ureter and can also be used to remove foreign bodies from the bile duct and blood vessels (col. 1, ll. 1-10). Relative movement of an inner wire and an outer sleeve actuates the basket. Therefore, it would have been obvious to one of ordinary skill in the art to modify the device of Mosier to replace the instrument (14) with one that has an expandable frame as made obvious by Dormia since the device is designed to be mounted to a variety of instruments and Dormia teaches that baskets are used by urologists to remove foreign bodies from natural passages in the body.

17. Regarding claims 19 and 40, Mosior discloses a grip portion (21c) having a sleeve defining an aperture, wherein the first retaining device is affixed to the sleeve (see fig. 1).

18. Regarding claims 24 and 45, the first retaining device (27) is in a fixed position.

19. Regarding claims 25 and 46, the second retaining device (23) is longitudinally movable from a first position to a second position relative to the first retaining member.

20. Regarding claims 26, 27, 47 and 48, the expandable frame made obvious by Dormia added to the actuator device of Mosior is controlled by relative movement of an inner wire with respect to an outer sleeve. In order to actuate the frame, it would be obvious to one skilled in

Art Unit: 3731

the art to have the frame be in a closed position when the second retaining device is in a first position and in an opened position when the retaining device is in a second position.

21. Regarding claims 28-31 and 49-52, the clips made obvious by Darrey are spring clips. Without further structure, any point of reference or any structure that aids in alignment on the spring clips can be considered an alignment indicator including the curved channel defined by the clamping ends 10b.

Allowable Subject Matter

22. Claims 3-6, 20-23, and 41- 44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

23. Claims 32-38 are allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Art Unit: 3731

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen Sonnett whose telephone number is 571-272-5576. The examiner can normally be reached on 7:30-5:00, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KCS 6/25/2007


GLENN K. DAWSON
PRIMARY EXAMINER